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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,736	12/30/2003	Amjad Hanif	3801.P177	9045

21186 7590 02/16/2005

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EXAMINER

HECK, MICHAEL C

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/749,736

Applicant(s)

HANIF ET AL.

Examiner

Michael C. Heck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-20,22,23,25 and 29-34 is/are rejected.
- 7) ☒ Claim(s) 8,21,24 and 26-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The following is a First Office Action in response to the application filed 30 December 2003. Claims 1-34 are pending in this application and have been examined on the merits as discussed below.

#### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 28, 41, 714, 810, 824, 826 and 916. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

3. The disclosure is objected to because of the following informalities:

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- On page 14, line 14, delete "(processing block 716)", and insert --(processing block 714) --.
- On page 19, line 3, delete "(processing block 828)", and insert --(processing block 824) --.

The above citation is a mere guide. Applicant is requested to review the specification thoroughly to eliminate additional errors. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 16-29** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For the process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case,

**claim 16** only recites an abstract idea. As to **claim 16**, the recited steps of receiving a request to cancel feedback pertaining to a transaction in a network-based transaction facility from a first party to the transaction; determining whether one or more feedback cancellation criteria are satisfied; and canceling the feedback pertaining to the transaction if the one or more feedback cancellation criteria are satisfied does not apply, involve, use, or advance the technological arts since all the recited steps can be performed in the mind of the user or by use of a pencil and paper. The method only constitutes an idea for canceling feedback, therefore, is deemed to be directed to non-statutory subject matter.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implications of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above. Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces canceled (i.e., repeatable) feedback (i.e., useful and tangible) pertaining to a transaction in a network-based transaction facility.

Looking at the claims as a whole, nothing in the body of the claims recite any structure or functionality to suggest that a computer performs a task. While claims 23 and 24 recite sending an email that includes a link to a feedback cancellation form, this amounts to only sending a message where nothing is done (i.e., computing) to breathe life into the invention.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, the same rejection as stated above for claim 16 applies to **claims 17-29**.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 10 and 16** are rejected under 35 U.S.C. 102(b) as being anticipated by eBay (eBay, eBay Feedback Removal Policy, 19 June 2000 [online – Internet Archive WaybackMachine – retrieved on 14 February 2005 – URL: <http://pages.ebay.com/help/community/fbremove.html>]). eBay discloses feedback cancellation in a network-based transaction facility comprising:

- **[Claim 16]** receiving a request to cancel feedback pertaining to a transaction in a network-based transaction facility from a first party to the transaction (Para 3, eBay teaches contacting eBay by writing [safeharbor@ebay.com](mailto:safeharbor@ebay.com) and seek review if you believe that another user has left feedback for you that meets one or more of the criteria. If eBay agrees with you, it will remove the feedback.);

- determining whether one or more feedback cancellation criteria are satisfied (Para 3-13, eBay teach circumstances (criteria) where eBay will consider removing feedback.); and
- canceling the feedback pertaining to the transaction if the one or more feedback cancellation criteria are satisfied (Para 3, eBay teaches that if eBay agrees with you, it will remove the feedback.).

**Claims 1 and 10** substantially recites the same limitations as that of claim 16 with the distinction of the recited method being an apparatus and system. Hence the same rejection for claim 16 as applied above applies to claims 1 and 10.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 2-7, 9, 11-15, 17-20, 22, 23, 25 and 29-34** are rejected under 35 U.S.C. 103(a) as being unpatentable over eBay (eBay, eBay Feedback Removal Policy, 19 June 2000 [online – Internet Archive WaybackMachine – retrieved on 14 February 2005 – URL: <http://pages.ebay.com/help/community/fbremove.html>] in view of SquareTrade (SquareTrade, How SquareTrade's Dispute Resolution Can Help Resolve Feedback Disputes, 12 March 2001, 18 June 2001, and 08 August 2002 [online – Internet Archive WaybackMachine – retrieved on 14 February 2005 – URL: [http://www.squaretrade.com/eb/ebay\\_nf\\_020801.html](http://www.squaretrade.com/eb/ebay_nf_020801.html)]). As to **claim 17**, eBay discloses feedback cancellation in a network-based transaction facility but fails to teach

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determining that a second party to the transaction agrees to cancel the feedback pertaining to the transaction. SquareTrade teaches eBay will consider your request for feedback removal when SquareTrade notifies eBay that you have reached an agreeable resolution with the other party (Para 3). It would have been obvious to one of ordinary skill in the art to include SquareTrade's agreement solution with the teachings of eBay since eBay teaches that it is old and well known in the art to have a feedback removal policy (eBay: Title). Both eBay and SquareTrade address how to resolve feedback disputes on eBay so the feedback can be removed, therefore the motivation to combine is based on the nature of the problem to be solved.

- **[Claim 18]** wherein the feedback pertaining to the transaction includes at least one of a feedback comment left by the first party for a second party to the transaction and a feedback comment left by the second party for the first party (SquareTrade: Para 1 and 3, SquareTrade teaches that if you have received feedback that you disagree with and want to have it remove, you can work with SquareTrade (eBay's preferred online dispute resolution provider) to try and resolve the underlying problem with the other eBay user. eBay will consider your request for feedback removal when SquareTrade notifies eBay that you have bought or sold an item that does not violate eBay policy.);
- **[Claim 19]** identifying a second party to the transaction based on input provided by the first party (SquareTrade: Para 1 and 3, SquareTrade teaches that if you have received feedback that you disagree with and want to have it remove, you can work with SquareTrade (eBay's preferred online dispute resolution provider) to try and resolve the underlying problem with the other eBay user.);
- presenting to the first party information identifying the second party and the feedback pertaining to the transaction (SquareTrade: Para 7-9, SquareTrade teaches entering complaint details on SquareTrade's secure and confidential Web site. SquareTrade will send notification email to the other party who can then respond to your complaint in a secure are on the SquareTrade Web site. When you receive a response, log in and request a SquareTrade Mediator.); and



- receiving a confirmation of the request to cancel feedback from the first party (SquareTrade: Para 10, SquareTrade teaches when you and the other eBay user have reached a resolution and completed all terms of that resolution as outlined by your mediator, SquareTrade will notify eBay and your feedback will be removed).
- **[Claim 20]** wherein the input provided by the first party includes an identifier of an item associated with the transaction (SquareTrade: Para 3, SquareTrade teaches eBay will consider your request for feedback removal when SquareTrade notifies eBay that you have bought or sold an item that does not violate eBay policy. Implicitly, an item is identified.).
- **[Claim 22]** notifying a second party to the transaction about the request to cancel feedback (SquareTrade: Para 7-9, SquareTrade teaches SquareTrade will send notification email to the other party who can then respond to your complaint in a secure are on the SquareTrade Web site.).
- **[Claim 23]** sending to the second party an email message informing the second party of the request to cancel feedback pertaining to the transaction (SquareTrade: Para 7-9, SquareTrade teaches SquareTrade will send notification email to the other party who can then respond to your complaint in a secure are on the SquareTrade Web site.).
- **[Claim 25]** presenting to the second party information identifying the transaction for which the first party submitted the request to cancel feedback (SquareTrade: Para 3 and 7-9, SquareTrade teaches eBay will consider your request for feedback removal when SquareTrade notifies eBay that you have bought or sold an item that does not violate eBay policy. SquareTrade will send notification email to the other party who can then respond to your complaint in a secure are on the SquareTrade Web site.); and
- receiving a confirmation of feedback cancellation from the second party (SquareTrade: Para 10, SquareTrade teaches when you and the other eBay user have reached a resolution and completed all terms of that resolution as outlined by your mediator, SquareTrade will notify eBay and your feedback will be removed).
- **[Claim 29]** wherein the one or more feedback cancellation criteria includes at least one requirement selected from the group consisting of a requirement that at least one feedback comment pertaining to the transaction exist, a requirement that the request to cancel feedback be received before an expiration date of the transaction, a requirement that a second party to the transaction agree to cancel feedback before an expiration date of the request to cancel feedback, a requirement that each of the first and second parties be

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currently registered with the network based transaction facility, and a requirement that each of the first and second parties do not exceed a feedback cancellation limit (SquareTrade: Para 1 and 3, SquareTrade teaches that if you have received feedback that you disagree with and want to have it remove, you can work with SquareTrade (eBay's preferred online dispute resolution provider) to try and resolve the underlying problem with the other eBay user. eBay will consider your request for feedback removal when SquareTrade notifies eBay that you have bought or sold an item that does not violate eBay policy. Implicitly, one feedback comment pertaining to the transaction exist.).

- **[Claim 30]** receiving a request to cancel feedback pertaining to a transaction in a network-based transaction facility from a first party to the transaction (eBay: Para 3, eBay teaches contacting eBay by writing [safeharbor@ebay.com](mailto:safeharbor@ebay.com) and seek review if you believe that another user has left feedback for you that meets one or more of the criteria. If eBay agrees with you, it will remove the feedback.);
- determining that a second party to the transaction agrees to cancel the feedback pertaining to the transaction (SquareTrade: Para 3, SquareTrade teaches eBay will consider your request for feedback removal when SquareTrade notifies eBay that you have reached an agreeable resolution with the other party.);
- determining whether one or more feedback cancellation criteria are satisfied (eBay: Para 3-13, eBay teach circumstances (criteria) where eBay will consider removing feedback.); and
- canceling the feedback pertaining to the transaction if the one or more feedback cancellation criteria are satisfied (eBay: Para 3, eBay teaches that if eBay agrees with you, it will remove the feedback.).

**Claims 2-7, 9, 11-15 and 31-34** substantially recites the same limitations as that of claims 17-20, 22, 29 and 29 with the distinction of the recited method being an apparatus, system, and computer readable medium. Hence the same rejection for claims 17-20, 22, 29 and 29 as applied above applies to claims 2-7, 9, 11-15 and 31-34.

***Allowable Subject Matter***

9. **Claims 8, 21, 24 and 26-28** would be allowable if rewritten to overcome the rejection under 35 U.S.C. 101 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Heck whose telephone number is (703) 305-8215. The examiner can normally be reached Monday thru Friday between the hours of 8:00am - 4:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (703) 305-9643. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

**Director of the United States Patent and Trademark Office  
P.O. Box 1450  
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Or faxed to:

**(703) 872-9306** [Official communications; including After Final communications labeled "**Box AF**"]

**(703) 746-9419** [Informal/Draft communication, labeled "**PROPOSED**" or "**DRAFT**"]

Hand delivered responses should be brought to 220 South 20<sup>th</sup> Street, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

mch  
14 February 2005

  
**TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**